Remarks

Reconsideration of this application is respectfully requested.

Claims 1 – 30 and 34 – 38 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 5,893,074 issued to Hughes et al ("Hughes") in view of U.S. Patent No. 6,684,212 issued to Day et al ("Day"). Claims 31 – 32 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Hughes in view Day and further in view Uchio et al., U.S. Patent Publication No. 2002/0019836 ("Uchio").

Claims 1, 6, 11, 16, 21, and 26 relate to a computer-implemented system and method for managing a project including assigning at least one task [or item] to at least one task [item] responsible person, wherein assigning the at least one task [item] comprises "providing candidate data representing attributes of candidates for the task [item] – responsible person, the candidate data comprising candidate names, field of expertise, workload and contact information." The Action admits that Hughes fails to disclose this feature and alleges that this missing feature is supplied in the disclosure of Day.

The Action alleges, at page 3, that Day discloses providing candidate data representing attributes of candidates for the task-responsible person. Specifically, the Action alleges that Day discloses: 1) candidate data comprising field of expertise at Figure 20, where reference numeral 332, PAD name, and reference numeral 336, organizational group, are equivalent to Applicants' field of expertise feature; 2) Figure 10, priority, is equivalent to Applicants' workload feature; 3) Figure 13, reference numeral 220, new team room template, is equivalent to Applicants' contact

information feature; and 4) all features of Figure 17, yet the Action fails to indicate any significance of the features of Figure 17 or any relevance to Applicants' claims.

With respect to the first allegation, the Action is incorrect that the PAD name 332 and organizational group 336 are equivalent to Applicants' candidate field of expertise feature. Day defines PAD, at column 11, lines 46 – 52, as a physical action description, "a single discrete action or activity that must be completed by the team in order to complete project . . . a PAD can be defined [as] any discrete aspect of the project . . . that relates to the successful outcome of the project." Organizational group, 336 is defined at column 12, lines 46 – 48, as a division of data entry, comparable to entering data by year. Figure 20 is a report form of PAD display, where a user is able to click on various "twisties" to get the data associated with a project team report. Nothing in Day discloses or suggests providing candidate data representing attributes of candidates for the task [item] responsible person including field of expertise as claimed by Applicants. Further, the Action has failed to explain why these features of Day are allegedly equivalent to the features as found in Applicants' claim, other than an unsupported conclusory statement that they are analogous.

With respect to the second allegation, the Action is incorrect that the term "priority" as used in by Day in Figure 10 is an equivalent to Applicants' claimed feature of candidate data comprising workload. At column 8 lines 24 -25, Day discloses that Figure 10 is an illustration of an email notification sent to a reviewer that a member of the team has completed a new issue document. Day discloses that any member of the team may raise an issue at any time by completing the new issue form, and that part of the basic information section of the form includes a field for selecting the level of priority assigned to this issue where red is assigned to high priority, yellow to medium priority and green to low priority. (See Day bottom of column 7,

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line 62 to column 8 line 51.) Nothing in the disclosure of Day, nor in Figure 10 itself, discloses or suggests anything related to providing candidate data representing attributes of candidates for the task [item] responsible person including the candidate's workload, as claimed by Applicants. Priority as used by Day in Figure 10 and throughout the disclosure relates to the priority coding given to an issue document created by a member of the team. Further, the Action has failed to explain why the "priority" feature of Day is allegedly equivalent to the candidate workload feature as found in Applicants' claim, other than an unsupported conclusory statement that they are analogous.

With respect to the third allegation, the Action is incorrect in alleging that the new team room template shown in Day, Figure 13, is an equivalent feature to Applicants' candidate contact information as claimed. The template, as disclosed by Day at column 9 lines 49 to column 10 line 3, is configured by an administrator or team leader to "obtain various information about the new team room." Among all of the possible selections, entries, and data fields included in new team template, none relate to candidates or candidate data for a task [item]. All fields and entries in the new team template relate to members who have already been selected for a task or item and have been assigned to a specific team, i.e., the new team for which an administrator is setting up a template. Nowhere in Figure 13 or in any of the disclosure of Day is there a teaching about providing candidates or candidate data, including candidate contact information for a task [item]. Further, the Action has failed to explain why the "new team template" feature of Figure 13 is an alleged equivalent to candidate contact information as claimed by Applicants, other than an unsupported conclusory statement that they are analogous.

Finally, none of the features of Day's Figure 17 appear to cure the deficiencies of the Hughes et al. Day fails to disclose or suggest, "providing candidate data representing attributes

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of candidates for the task [item] – responsible person, the candidate data comprising candidate names, field of expertise, workload and contact information," as claimed. Further, the Action has not equated any particular teaching in Day to any specific feature of Applicants' claims.

Moreover, the Action alleges at page 4, with respect to claims 1, 6, 11, 16, 21, and 26, that Hughes discloses "means for permitting at least one other person to have read-only access to the task report" and further cites as support for such allegation, Hughes column 8, lines 10 – 13. The Action is incorrect in the allegation. Hughes, column 8, lines 10 – 13 refers to the middle of a box of comments under the title "DATES NOT AGREED STATE" and states "The product was reconciled. The supplier cannot make the original agreed-to delivery date, and has changed it to a later date" Nowhere in this statement is any reference of any kind made to a person having or being provided read-only access to a task or item report. Furthermore, the comment explicitly states that the supplier has changed the delivery date in the system, clearly an example of read-write capability, not read-only access. In fact, Hughes is directed to providing the work force involved with the project control over editing, updating, and distribution information relevant to their particular task. At column 6, lines 5 – 8, Hughes states, "In this way management of the project is distributed over and controlled by the project's entire work force, with each employee directly controlling his or her contract." (emphasis added). And at column 2, lines 32 – 34, Hughes states, "The combination of these features [of Hughes' invention] allows users to quickly and easily supply input data and access output data." (emphasis added). Also, at column 3, lines 22 – 25, Hughes states, "All levels of the project's suppliers and receivers- . . . – can use the schedule-control method to control and iterate their portion of the project." (emphasis added). Thus, Hughes fails to disclose or suggest a person having or provided read-only access to a task/item report, a feature present in Applicant's claims 1, 6, 11, 16, 21, and 26.

In order to establish a prima facie case of obviousness, the prior art references, when combined, must teach or suggest each and every feature of the claimed invention. MPEP 2143. The Action has failed to do so because Day fails to provide the teachings which the Action admits are missing from Hughes. Specifically, Day fails to teach "providing candidate data representing attributes of candidates for the task [item] – responsible person, the candidate data comprising candidate names, field of expertise, workload and contact information." Moreover, the mere fact that references can be combined is not sufficient to establish obviousness. MPEP 2143.01. There must be some suggestion or motivation to modify or combine the references in the particular manner alleged in the Action and the suggestion or teaching must be supplied from the prior art and not Applicants' disclosure. MPEP 2142. Furthermore, the level of skill in the art cannot be used as a basis to suggest the desirability of the combination. MPEP 2143.01.

Here, the Action has failed to provide any basis that there is any suggestion or motivation for combining Hughes and Day in the manner alleged by the Action. While both Hughes and Day are related to the field of project management systems, neither relate to the other, nor do they suggest the desirability of combination. Hughes is directed to a project management system for managing large-scale production of unique "one-of-kind" items. At column 1 line 51 to column 2, line 5, Hughes explains the purpose of his project management system as one that will facilitate good communication between suppliers and receivers including a structured methodology for defining, recording and processing the multiple variables associated with the large-scale projects envisioned by Hughes in order to meet important due dates.

Conversely, Day is directed towards a project management system for managing data and information between diverse organizations and data management systems. At column 1, line 20,

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to column 2 line 13, Day discloses the purpose of the invention and its advantages over the prior art. Day is directed towards overcoming the prior art shortcomings related to using discreet modes of electronic information transmission, i.e., email, voicemail, and the Internet where all participants previously did not have equal access. Day also is directed towards overcoming the problems encountered when two different organizations must work on a similar project wherein each organization utilized different software. Finally, Day also seeks to overcome the disadvantage of the "war room" where people involved in the project must all be physically present at the same location in order to have full access to all of the data generated during the project.

Thus, Hughes and Day are directed towards completely separate and distinct problems in the field of project management. One skilled in the art would not be inclined to combine the teachings in Hughes with those of Day because Hughes is directed towards facilitating large scaled production projects of a "one-of-a-kind" nature, whereas Day is directed towards facilitating a better project management system between and among groups and organizations with different software resources and a need to have a physical location where all project data is available to team members.

Accordingly, the Action has failed to show that the combination of Hughes and Day teaches each and every feature of Applicants' invention as claimed in claims 1, 6, 11, 16, 21, and 26. Additionally, the Action fails to show the desirability of the combination of Hughes and Day. Thus, the Action has failed to establish the obviousness of Applicants' claims. Withdrawal of the rejection is requested. Claims, 2 – 5, 7 – 10, 12 – 15, 17 – 20, and 27 – 30 are either directly or indirectly dependent from claims 1, 6, 11, 16, 21, and 26 and should be allowable at least through dependency.

Claim 31 is directed towards a computer implemented <u>patent opinion</u> integration system including "means for sending a request for a <u>patent opinion</u>," "means for receiving the <u>patent opinion</u> details," "a database for associating the <u>patent opinion</u> with the patent related data and for storing the <u>patent opinion</u>." The Action admits that both Hughes and Day fail to teach any features related to patent data and alleges that Uchio supplies the missing teachings.

However, the Action fails to show that Uchio provides any teachings regarding a <u>patent opinion, or any other type of opinion whatsoever</u>. As Applicants' have already stated in their prior response a "patent opinion" is a well understood term to describe a specialized analysis performed by a qualified and licensed patent attorney regarding a legal question or issue related to a patent. There is no disclosure or teaching of a "patent opinion" in Uchio; in fact the term "opinion" is wholly absent from the Uchio disclosure.

Moreover, it appears the Action has contrived to take the previous basis of this claim's rejection under Hughes (see Non-Final Action dated Feb. 8, 2006, p. 7), highlight and bold the term **patent** in front of the word "opinion" (see pages 11 and 12 of the Final Action) and proceed to restate the same basis of the rejection under the incorrect assumption that because Uchio discloses the term "patent" the remainder of previous basis for rejection is still valid. Not only is this assumption incorrect on the part of the Action, it is a clear indicator of impermissible hindsight on the part of the Examiner and shows that the Examiner merely used Applicants' disclosure as a blueprint to go back through the prior art to piecemeal reconstruct Applicants' claimed invention in the prior art. MPEP 2141.01 III.

Furthermore, the mere fact that references can be combined is not sufficient to establish obviousness. MPEP 2143.01. There must be some suggestion or motivation to modify or

combine the references in the particular manner alleged in the Action and the suggestion or teaching must be supplied from the prior art and not Applicants' disclosure. MPEP 2142. Additionally, the level of skill in the art cannot be used as a basis to suggest the desirability of the combination. MPEP 2143.01. Here, the Action has failed to provide any basis that there is any suggestion or motivation for combining Hughes with Uchio in the manner alleged by the Action. Hughes is directed to a project management system for managing large-scale production of unique "one-of-kind" items. At column 1 line 51 to column 2, line 5, Hughes explains the purpose of his project management system as one that will facilitate good communication between suppliers and receivers including a structured methodology for defining, recording and processing the multiple variables associated with the large-scale projects envisioned by Hughes in order to meet important due dates. Conversely, Uchio is directed towards a method and storage medium for the processing and storage of documents related to patents and patent applications. Hughes and Uchio are directed towards completely separate and distinct problems; Hughes being directed towards project management and Uchio towards patent information storage and retrieval. One skilled in the art would not be inclined to combine the teachings in Hughes with those from Uchio.

Because the Action has failed to show that the combination of Hughes and Uchio fails to teach or disclose each and every feature of Applicants' claim 31; namely a "patent opinion" and further because the Action fails to show the teaching, motivation, or suggestion to combine the Hughes and Uchio references, the obviousness rejection fails. Withdrawal of the rejection is requested. Claims 39 – 41 are dependent from claim 31 and should be allowable at least through dependency.

Claim 39 includes the feature of whether a specific patent is infringed. The Action alleges that Uchio discloses a teaching of patent infringement with respect to the obtaining of a patent opinion. Nowhere does the term "infringe" or any derivation thereof appear in the entirety of the Uchio disclosure. The Action attempts to associate several disparate section of the Uchio disclosure into an attempt to contrive a reading of a patent opinion associated with patent infringement. This wholly fails. The Action points to paragraph [0149], which relates to invoice payment process, paragraph [0168] which relates to the opening or unopening of transmission notification and paragraphs [0177] and [0178] which relate to a display method.

The Action totally ignores the limitation that the Patent and Trademark Office (PTO) must give the claims a **reasonable** interpretation. The Action alleges that paragraph [0149] teaches a patent opinion, but paragraph [0149] deals with processing of invoices, as made clear when paragraphs [0148] and [0149] are read together. The PTO cannot reasonably construe the term "patent opinion" to mean an invoice.

Similarly, the Action alleges that in paragraphs [0177] and [0188], the failure of a person to take an action (such as responding to a communication from the PTO), can be interpreted as meaning that a patent is disregarded and infringed. However, failing to respond to a communication from the PTO has nothing to do with infringing any patent (not even the patent cited in the office action). Even if it is assumed that an applicant does not respond to an official action because the applicant deems the pending claims to be unpatentable over the complete disclosure of a cited prior art reference, that has nothing to do with infringement. Infringement is a comparison of the claim in the reference to an actual product or process, whereas patentability is a comparison between claims in a patent application and the entire disclosure of a reference. These are two entirely unrelated comparisons, and the PTO has failed to show that

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Uchio disclose or suggests any opinion of any kind, much less a patent opinion. Nor can a patent opinion be construed to cover the failure to respond to an official action.

Absent from all of these references is any actual disclosure of patent infringement and any mention of a patent opinion concerning patent infringement. The Action fails to show that Uchio separately or in combination with Hughes, and Day, teaches each and every feature of Applicants' claim 39. Thus, the obviousness rejection fails. Withdrawal of the rejection is requested.

Further, the Action rejects claims 34 – 38, 40 and 42 based upon a combination solely of Hughes and Day (see Final Action pp. 8 -10). Applicants' had in the prior response dated May 11, 2006, changed the dependency of claims 34 -38 from claim 22 to claim 32. The Action admits at page 11, that Hughes and Day fail to teach all of the features of Applicants' claim 32. Therefore because the Action admits that Hughes and Day in combination do not supply all of the claimed features of independent claim 32, the Action inherently admits that Hughes and Day in combination would similarly fail to supply all of the features present in dependent claims 34 – 38. Similarly, claims 40 and 42 are dependent from claim 31, and the Action admits that Hughes and Day fail to provide a teaching of all limitations of claim 31. Therefore because the Action admits that Hughes and Day in combination do not disclose all of the claimed features of independent claim 31, the Action inherently admits that Hughes and Day in combination would similarly fail to supply all of the features present in claims 40 and 42, which are dependent on claim 31. Therefore, the rejections of clamis 34-38, 40 and 42 are improper. Withdrawal of the rejection to claims 34 – 38, 40 and 42 is requested.
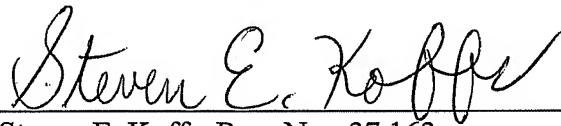
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In view of the foregoing amendments and remarks, Applicant submits that this

application is in condition for allowance. Early notification to that effect is respectfully

requested.

The Assistant Commissioner for Patents is hereby authorized to charge any additional

fees or credit any excess payment that may be associated with this communication to deposit

account **04-1679.**

Respectfully submitted,

Dated: 10/25/06

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